

REMARKS / DISCUSSION OF ISSUES

Claims 1-14 are pending in the application. No claims are cancelled. Claims 1, 8 and 13 are the independent claims. Unless indicated the contrary, the pending claims have been amended to better define Applicants' contribution to the art, as well as to conform to current U.S. patent practice, including correcting one or more informalities, and/or replacing European-style claim phraseology with U.S.-style claim language, without addressing any issues of patentability.

Objection to the Claims

Applicants have reviewed the objections to claims 1, 8 and 13. The amendment to claims 1, 8 and 13 overcomes the objections. Withdrawal of the objections is earnestly solicited.

Rejections under 35 U.S.C. § 112, ¶2

Applicants have reviewed the rejection under this section of the Code. The amendments to claims 5-8 is believed to render the rejection moot. Withdrawal of the rejection is earnestly solicited.

Rejections under 35 U.S.C. § 103

Claims 1-14 are rejected under 35 U.S.C. § 103(a) as allegedly being obvious in view of Applicants admitted prior art (Fig. 1) and *Shippee, et al.* (U.S. Patent 6,326,721). For at least the reasons set forth below, Applicants respectfully submit that the claims 1-14 are patentable over the applied art.

A *prima facie* case of obviousness has three requirements. First, the prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, requires some reason that the skilled artisan would modify a reference or to combine references.¹ The Supreme Court has, however, cautioned against the use of

¹ See Princeton Biochemicals, Inc. v. Beckman Coulter, Inc., 411 F.3d 1332 (Fed. Cir. 2005) (“[S]imply identifying all of the elements in a claim in the prior art does not render a claim obvious.”).

“rigid and mandatory formulas” particularly with regards to finding reasons prompting a person of ordinary skill in the art to combine elements in the way the claimed new invention does.² But rather the Supreme Court suggests a broad, flexible “functional approach” to the obviousness analysis recognizing that “[i]n many fields it may be that there is little discussion of obvious techniques or combinations.”³ Second, the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the same time the invention was made. In other words, a hindsight analysis is not allowed.⁴ Lastly, the prior art reference or combination of references must teach or suggest all the limitations of the claims.⁵

A. Claims 1, 8 and 14 are patentable over the applied art

Claim 1 recites:

An electric lamp, comprising:

a light source capsule energizeable for emitting light, the light source capsule comprising a seal, the seal comprising two substantially parallel major faces and two opposing minor faces extending transversely between the major faces, and a stem portion and at least one support rod extending adjacent a minor face of the seal; and

*a strapless mount structure, comprising: **a main frame portion comprising an insulative sleeve disposed over a portion of the main frame portion; a first metallic support rod extending from the stem portion and fixed to the main frame portion; and a second metallic support rod engaging the dome end of the envelope and fixed to the main***

² See KSR Int’l Co. v. Teleflex Inc., 127 S. Ct. 1727 (2007) (“The obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation, or by overemphasis on the importance of published articles and the explicit content of issued patents.”).

³ Id. See also Id. at 1743 F. 3d 1356 (Fed. Cir. 2006) (“Our suggestion test is in actuality quite flexible and not only permits, but *requires*, consideration of common knowledge and common sense”) (emphasis in original).

⁴ See Amgen, Inc. v. Chugai Pharm. Co., 927 F.2d 1200 (Fed. Cir. 1991) (“Hindsight is not a justifiable basis on which to find that ultimate achievement of a long sought and difficult scientific goal was obvious.”).

⁵ See In re Wilson, 424 F.2d 1382 (C.C.P.A. 1970) (“All words in a claim must be considered in judging the patentability of that claim against the prior art.”).

frame portion.

Claims 8 and 14 each include the emphasized features of claim 1, and are patentable for at least the same reasons.

In rejecting claim 4, the Office Action concedes that the applied art fails to disclose that an “insulative covering is present on at least a portion of said main frame.” The Office Action then asserts:

“It would have been obvious to one of ordinary skill in the art at the time the invention was made to have an insulative covering is present on at least a portion of said main frame in the lamp disclosed by AAPA in view of Shippee, for the purpose of reducing the possibility of having the main frame rust during the life [of] the lamp thereby enhancing the life of the lamp.”

Applicants respectfully submit that there is no disclosure of an insulative sleeve in the applied art, and the rejection relies improperly on hindsight analysis using Applicants’ claims as templates for their own reconstruction. Notably, there is not only no disclosure of the insulative sleeve in the applied art, but also there is no motivation from the applied art to warrant or otherwise support the inclusion of an insulative sleeve. Stated somewhat differently, Applicants respectfully submit that but for their claims as templates for their own reconstruction, there would be no basis to include the insulative sleeve. As such, the proffered motivation is not sanctioned in the determination of patentability.

Moreover, a claim rejection must be based on objective evidence of record, and cannot be supported merely on subjective belief and unknown authority.⁶ No such concrete evidence has been provided by the Examiner here, nor did the Examiner submit an affidavit as required by 37 C.F.R. § 1.104(d)(2) if this proposed motive were based on facts within his personal knowledge (see M.P.E.P. § 2144.03). Applicants respectfully request that such an affidavit be provided if a rejection continues to be made without a citation of any objective evidence.

For at least the reasons set forth above, Applicants respectfully submit that the

⁶ See, e.g., M.P.E.P. § 2144.03; In re Lee, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); In re Zerko, 258 F.3d at 1386, 59 USPQ2d at 1697.

applied art fails to disclose or fairly suggest at least one feature of each of claims 1, 8 and 14. Therefore, a *prima facie* case of obviousness cannot be based on the applied art, and claims 1, 8 and 14 are patentable over the applied art.

B. General Comments on Rejections of Dependent Claims

Since each of the dependent claims depends from a base claim that is believed to be in condition for allowance, Applicant believes that it is unnecessary at this time to argue the allowability of each of the dependent claims individually. Applicant does not, however, necessarily concur with the interpretation of any dependent claim as set forth in the Office Action, nor do Applicant concurs that the basis for the rejection of any dependent claim is proper. Therefore, Applicant reserves the right to specifically address the patentability of the dependent claims in the future, if deemed necessary.

Conclusion

In view the foregoing, applicant(s) respectfully request(s) that the Examiner withdraw the objection(s) and/or rejection(s) of record, allow all the pending claims, and find the application in condition for allowance.

If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted on behalf of:
Phillips Electronics North America Corp.

/William S. Francos/

by: William S. Francos (Reg. No. 38,456)

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Volentine & Whitt, PLLC
Two Meridian Blvd.
Wyomissing, PA 19610
(610) 375-3513 (v)
(610) 375-3277 (f)